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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/707,570

Filing Date: December 22, 2003

Appellant(s): KISSNER ET AL.

George M. Macdonald
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 16, 2009 appealing from the
Office action mailed July 16, 2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

02/39378	Wiebe	5-2002
7,222,098	Silverbrook	5-2007

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-13 and 21-24** are rejected under 35 U.S.C 103(a) as being unpatentable over Wiebe (WO 02/39378 A1) in view of Silverbrook et al. (US Pat No. 7,222,098 B2) and official notice.

3. Regarding claims 1-2 and 21-24, Wiebe discloses a method for presenting a digital paper consolidated bill comprising: receiving data relating to a bill from a merchant (Page 23 lines 26-35); associating a digital paper pattern with a consolidated bill (Figure 4, page 23 lines 26-35); creating the digital paper bill using the data relating to the bill and the digital paper pattern; and providing the digital paper bill to a consumer (Page 23 line 29 – Page 24 line 19); receiving a payment request from the consumer, wherein the consumer uses a digital pen to process the payment request (Page 23 lines 26-35); authenticating the payment request (Page 13 line 36 – Page 14 line 4); and processing a bank payment request from a bank in order to process the payment request (Page 24 lines 5-31).

4. Wiebe fails to explicitly disclose associating a stored consumer biometric signature with the bill.
5. However, Silverbrook discloses associating a stored consumer biometric signature with the bill (Column 9 lines 3-21, Column 30 lines 3-12).
6. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Silverbrook in the device of Wiebe reference to include associating a stored consumer biometric signature with a bill in order to take advantage of current reliable technology to enhance authentication.
7. Regarding Claim 6, Wiebe fails to explicitly disclose a method further comprising sending a payment processed receipt to the consumer related to the payment processed notice.
8. However, Examiner takes official notice that sending a payment processed receipt to the consumer related to the payment processed notice is old and well known in the art at the time the invention was made.
9. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a method comprising sending a payment processed receipt to the consumer related to the payment processed notice, for the advantage of providing a consumer with payment verification.
10. Regarding Claim 7, Wiebe fails to explicitly disclose a method wherein, the data relating to a bill includes XML formatted data.
11. However, Examiner takes official notice that XML formatted data is old and well known in the art at the time the invention was made.

12. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a method wherein, the data relating to a bill includes XML formatted data, for the advantage of providing consumers with a common and standardized data format.
13. Regarding claim 3, Wiebe discloses a method further comprising: obtaining a consumer payment preferences record used for processing the bank payment request (Page 24 lines 26-31).
14. Regarding claim 4, Wiebe discloses a method further comprising: requesting a funds availability determination from the bank relating to the payment request and indicating any shortfall to the consumer (Page 24 Line 32 – Page 25 line 14).
15. Regarding claim 5, Wiebe discloses a method further comprising: receiving a payment processed notice from the bank relating to the payment request (Page 21 Lines 28-33, Page 24 Lines 12-31, receiving back a network address of the bank's computer reads on a payment processed notice).
16. Regarding claim 8, Wiebe discloses a method wherein, the consumer uses a cellular telephone to process the payment request (Page 21 lines 28-33).
17. Regarding claim 9, Wiebe discloses a method wherein, the payment request includes an indication that the consumer used the digital pen to check an digital pen pattern box within a confirmation time window (Abstract, Page 5 lines 1-5, Page 6 line 22 – Page 7 line 2).
18. Regarding claim 10, Wiebe discloses a method wherein, the digital paper comprises a unique digital pen pattern (Page 23 line 36 - Page 24 line 4).

19. Regarding claim 11, Wiebe discloses a method wherein, the digital paper comprises a generic digital pen pattern and a payment check box including a unique digital pen pattern (Page 23 line 36 - Page 24 line 19).
20. Regarding claim 12, Wiebe discloses a method wherein, the payment request includes an indication that the consumer used the digital pen to write a payment amount in an digital pen pattern box (Page 20 lines 5-15, Page 24 lines 12-19).
Regarding claim 13, Wiebe discloses a method wherein, the payment request includes an indication that the consumer used the digital pen to check a payment dispute digital pen pattern box (Page 24 lines 5-11, invoice in question reads on payment dispute).

(10) Response to Argument

Argument A: The examiner erred in withdrawing claims 14-16 from consideration.

In response to applicant's arguments, it is noted that objections to a restriction requirement is a petitionable matter and not an appealable matter. The MPEP cites:

818.03(c) [R-3] Must Traverse To Preserve Right of Petition
37 CFR 1.144. Petition from requirement for restriction.

">After a final requirement for restriction, the applicant, in addition to making any reply due on the remainder of the action, may petition the Director to review the requirement. Petition may be deferred until after final action on or allowance of claims to the invention elected, but must be filed not later than appeal. A petition will not be considered if reconsideration of the requirement was not requested (see § 1.181).

If applicant does not distinctly and specifically point out supposed errors in the restriction requirement, the election should be treated as an election without traverse and be so indicated to the applicant by use of form paragraph 8.25.02

The line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the "Director of the U.S. Patent and Trademark Office (Director)" should be carefully observed. The Board will not ordinarily hear a question "that" should be decided by the "Director on petition", and the "Director" will not ordinarily entertain a petition where the question presented is "a matter appealable to the Board". However, since 37 CFR 1.181(f) states that any petition

not filed within 2 months from the action complained of may be dismissed as untimely and since 37 CFR 1.144 states that petitions from restriction requirements must be filed no later than appeal, petitionable matters will rarely be present in a case by the time it is before the Board for a decision. *In re Watkinson*, 900 F.2d 230, 14 USPQ2d 1407 (Fed. Cir. 1990).

Argument B: Wiebe and Silverbrook fail to *teach associating a stored biometric signature with the bill.*

In response, the Examiner respectfully disagrees. Silverbrook discloses associating a stored biometric signature with the bill (Column 9 Lines 3-21, Column 30 lines 3-12). Additionally, Silverbrook discloses in more detail the association of stored biometric signature with a printed bill (Column 34 L59 – Column 35 L26, Column 36 Lines 1-32). It is respectfully noted that applicant is claiming an association of the biometric signature with a digital paper bill and therefore examiner points out that Wiebe in view of Silverbrook clearly discloses such an association. Furthermore, it is noted that applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). It is also noted that the features upon which applicant relies in the arguments (i.e., a printed digital paper bill) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Argument C: Wiebe and Silverbrook fail to *teach indicating any shortfall to the consumer.*

In response, the Examiner respectfully disagrees. Wiebe discloses information look-up in order to obtain details of account from which the money for payment is to be taken and using obtained information to carry out the transfer from pen owner's account which implicitly reads on the broad recitation of "**any** shortfall to the consumer" (Page 24 Line 32 – Page 25 line 14).

Argument D: Wiebe and Silverbrook fail to *teach receiving a payment processed notice.*

In response, the Examiner respectfully disagrees. Wiebe discloses payment information being returned to the pen owner which reads on receiving payment processed notices (Page 5 lines 1-5, Page 21 Lines 28-33, Page 24 Lines 12-31).

Argument E: It is not clear if official notice is applied in rejecting claims 6-7.

In response, the examiner points to the Final Rejection Dated July 16, 2009 in which claims 6 and 7 were rejected under 35 U.S.C 103(a) and in which the official notice taken was detailed in the Response to arguments section of that rejection. In order to clarify use of official notice to applicant, the rejection section of this Examiner Answer has been formatted to clearly specify the use of the official notice as originally presented in the first office action dated April 23, 2008. Examiner pointed out in the rejection Dated July 16, 2009 that applicant's traversal of official notice is inadequate.

MPEP 2144.03(c) requires that the applicant subsequent action adequately traverse the statement that certain subject matter is old and well known art. It further notes that an adequate traversal must state why it is believed that the subject matter is not old and well known.

MPEP 2144.03(c) states C. If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding With Adequate Evidence

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR1.111(b). See also Chevenard, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention."). A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate. If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR1.104(c)(2). See also Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2).

The appellant failed to specifically point out the supposed errors in the examiner's action dated 04/23/2008, and to state why the notice fact is not considered to be common knowledge or well known in the art, therefore In view of the inadequate traversal, and in light of the requirements of 2144.03(c), ***the examiner notes that the well known in the art statements of the previous Office Action are considered to***

be admitted prior art. Furthermore the Official Notice Traversal is no longer seasonable, therefore the Official Notice is considered to be admitted prior art.

Argument F: Wiebe and Silverbrook fail to teach a confirmation time window.

In response, the Examiner respectfully disagrees. Wiebe discloses an indication that the consumer used the digital pen to check digital pen pattern box and having a receipt or confirmation that the reading off has been carried out which implicitly reads on including an indication “**within a confirmation time window**” (Abstract, Page 5 lines 1-5, Page 6 line 22 – Page 7 line 2). The phrase “within a confirmation time window” does not place restriction on a pre-set or determined or established “time window” and thus an implicit or explicit disclosure of functional features reads on the limitation as currently recited.

Argument G: Wiebe and Silverbrook fail to teach receiving a payment request including a hand-written amount.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., receiving a payment request including a **hand-written** amount) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, Wiebe discloses writing

payment amount on Page 25 lines 8-14 and specifies being able to handwrite information on page 20 lines 3-15.

Argument H: Wiebe and Silverbrook fail to *teach a receiving a dispute indicator*.

In response, the Examiner respectfully disagrees. Wiebe discloses the payment request includes an indication that the consumer used the digital pen to check a payment dispute digital pen pattern box (Page 24 lines 5-11, invoice in question reads on payment dispute).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Faris Almatrahi/

Examiner, Art Unit 3627

Conferees:

/F. Ryan Zeender/

Supervisory Patent Examiner, Art Unit 3627